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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,053	07/10/2003	Bob Ching	CSC-023443-US	4311
1726	7590	01/26/2006	EXAMINER	
INTERNATIONAL PAPER COMPANY 6285 TRI-RIDGE BOULEVARD LOVELAND, OH 45140			FORTUNA, JOSE A	
			ART UNIT	PAPER NUMBER
			1731	

DATE MAILED: 01/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/618,053

**Applicant(s)**

CHING ET AL.

**Examiner**

José A. Fortuna

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 22 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 and 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/04; 10/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Election/Restrictions***

1. Applicant's election with traverse of November 14, 2005 is acknowledged. The traversal is on the ground(s) that the examiner has not provided evidence(s) that the inventions, can be used in a materially different process and/or that the product can be made by a materially different process of making. This is unconvincing, because restrictions do not require a showing of evidence(s) and or a search in the art. Restrictions are based in the examiner's knowledge of the art and the scope of the claims as claimed and no evidence is necessary. However, the examiner assertion/conclusion can be rebutted by a showing and/or evidence. The guidelines for restriction are shown below, (emphasis added):

Examiners must provide reasons and/or examples to support conclusions, but need not cite documents to support the restriction requirement in most cases. Where plural inventions are capable of being viewed as related in two ways, both applicable criteria for distinctness must be demonstrated to support a restriction requirement.

If there is an express admission that the claimed inventions would have been obvious over each other within the meaning of 35 U.S.C. 103, restriction should not be required.

In re Lee, 199 USPQ 108 (Comm'r Pat. 1978).

***For purposes of the initial requirement, a serious burden on the examiner may be prima facie shown by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02. That prima facie showing may be rebutted by appropriate showings or evidence by the applicant.*** Insofar as the criteria for restriction practice relating to Markush-type claims is concerned, the criteria is set forth in MPEP § 803.02. Insofar as the criteria for restriction

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or election practice relating to claims to genus-species, see MPEP § 806.04 - § 806.04(i) and § 808.01(a).

Since, applicants has not presented any evidence to rebut the examiner's restriction and since the examiner has shown examples to support the conclusions, i.e., paragraphs 2-4 indicate the conclusions/assertions and examples of why the inventions are different, the requirement is still deemed proper and is therefore made FINAL.

1. Claims 22 and 23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on November 14, 2005.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 19 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 is vague and indefinite, because a broad range or limitation followed by linking terms (e.g., **preferably**, maybe, for instance, especially) and a narrow range or limitation within the broad range or limitation is considered indefinite since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired.

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***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lau et al., US Patent No. 6,254,725 in view of Koivukunnas et al., US Patent Application Publication No. 2003/0101880 A1 and further evidenced by Sing et al., US Patent No. 6,332,953.

Regarding claims 1-7, 20-21, and 24, Lau et al. teach a method and apparatus for making high bulk, lightweight, coated and calendered paper, see abstract. Lau et al. teach also that the paper is made using a mixture of mechanical pulp and other pulps, including chemical pulps. The content of the mechanical pulp in the mixture is within the claimed range; see column 1, lines 23-51 and examples, (for the use of chemical pulps, e.g. Kraft pulp). The coating per side is within the claimed range i.e., at least 2.0 lbs/3300 ft<sup>2</sup> see column 2, lines 24-68, where they show coating weights per side between 5-11 lbs/rm, rm is equal to 3300 ft<sup>2</sup>. The caliper of the paper seems to be within the claimed range, since they teach calipers of the calendered paper between 1.75-2.2 mils. Note that the claimed caliper, in claim 1, is after coating but before calendering, and the ones shown by the primary reference is the calendered paper. Therefore, it is clear that the coated paper of Lau et al. would have at least 2.6 mils before calendering, since it is known that calendering reduces caliper at least 40%. The moisture content of the papers before coating is usually less than 10%, see column 3, lines 50-53, which falls within the claimed ranges. The only difference between the claimed invention and the primary reference, Lau et al., is the use of extended nip calenders, as opposed to supercalenders and/or hot-soft calenders of the primary reference. However, substituting the calender device taught by Lau et al. with extended nip calenders would have been obvious to one of ordinary skill in the art, since it is very well known to extended nip calenders when bulk conservation is of concern, i.e., it is very well known in the art that extended nip press preserves bulk better than other types of calenders, see for example paragraph [0004] of Koivukunnas et al. for evidence. Moreover, Koivukunnas et al. teach a

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modified supercalender device having at least 1 extended nip within the calender device, see figures and abstract. Koivukunnas et al. teach that their calender obtain smoothness<sup>1</sup> comparable to the ones obtained with conventional supercalender, while preserving bulk. Therefore, substituting the calender taught by Koivukunnas et al. for the calenders suggested by Lau et al. would have been obvious to one of ordinary skill in the art, in order to obtain smoothness comparable to conventional supercalenders while maintaining bulk. Lau et al. teach the same range of desired linear/lineal pressure at the calender nip, i.e. 800-1200 PLI, column 4, lines 40-67. Note also that extended nip calenders are operated at such lineal pressure and having the width within the claimed range, see for example, column 3, lines 16-34 of Sing et al. As to claims 8-18, Lau et al. teach the same type of coating pigments and disclose the same Tradenames/Trademarks as claimed, see column 3, line 54 through column 4, line 39 and therefore, the pigments must have the same claimed properties. As to claim 19, Lau et al. teach the use of blade coaters to coat the base paper, see column 4, lines 23-39.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure in the art of "Making High Bulk Coated Papers."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to José A. Fortuna whose telephone number is 571-272-1188. The examiner can normally be reached on 9:30-6:00.

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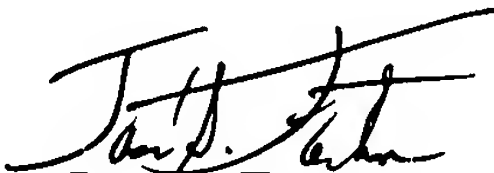
<sup>1</sup> The smoothness of papers calendered using extended nip calenders is lower than using a comparable supercalender, see Koivukunnas et al., paragraph [0004].



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



José A Fortuna  
Primary Examiner  
Art Unit 1731

JAF